

REMARKS

Claims 1-32 and 79 are pending, of which claims 1-3 and 11-15 have been examined, while claims 4-10 and 16-32 have been withdrawn from further consideration by the Examiner. Independent claim 1, as amended, is fully supported by the original written description, e.g., including, but not limited to, pages 14-16 of the specification and FIGS. 18-21.

Allowable Subject Matter

The Examiner has indicated that claim 14 is allowable. Claim 14 has been rewritten as new independent claim 79.

Election/Restriction

Claims 4-10 and 16-32 have been withdrawn from further consideration by the Examiner as being directed toward a non-elected species. Applicant requests that claims 4-10 and 16-32 be rejoined if generic claim 1 is allowed.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-3, 11-13 and 15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Treacy (U.S. Patent No. 5,716,362). This rejection is respectfully traversed.

Treacy does not describe or suggest a “second instrument mountable to [a] first instrument that includes a surface that is configured to be placed arthroscopically against a posterior surface of the patella,” as now claimed in claim 1 (Emphasis added).

The Examiner’s rejection states that Treacy shows “a second instrument 16 that is mountable to the first instrument that includes a foot 14 having a generally flat upper surface that is capable of being pressed against the posterior surface of the patella.” See Final Office Action, page 2. However, the base member 14 of Treacy’s handle assembly 16 is not configured to be placed arthroscopically against a posterior surface of the patella, as set forth in claim 1. Rather, as described by Treacy, see, e.g., col. 5, lines 11-40; and FIGS. 6-7, a surgeon places the clamps 20 and 24 of base member 14 on the patella from the anterior side of the patella, i.e., with clamps

20 and 24 facing posteriorly, flips the device in the medial-lateral direction to expose the posterior surface of the patella, and then attaches an arm 26, including milling tool 32, to post 18 and mills the patella in what apparently must be an open surgery. Therefore, applicant submits that claim 1, and its dependent claims, are patentable over Treacy for at least this reason.

Citation of Prior Art

The Examiner cited, but did not rely upon, Davis (U.S. Patent No. 4,235,428), stating "Davis (U.S. Patent 4,235428) shows a surgical instrument device that is capable of being used on a patella and that also anticipates under 102(b) all of claims 1-3, 11-13 and 15." Applicant submits that Davis does not describe or suggest at least the claimed second instrument that is mountable to a first instrument and that includes a surface that is configured to be placed arthroscopically against a posterior surface of the patella.

Applicant does not acquiesce in the Examiner's characterizations of the art. For brevity and to advance prosecution, Applicant may have not addressed all characterizations of the art and reserve the right to do so in further prosecution of this or a subsequent application. The absence of an explicit response by Applicant to any of the Examiner's positions does not constitute a concession of the Examiner's positions. The fact that Applicant's comments have focused on particular arguments does not constitute a concession that there are not other arguments for patentability of the claims. Applicant submits that all of the dependent claims are patentable for at least the reasons given with respect to the claims on which they depend.

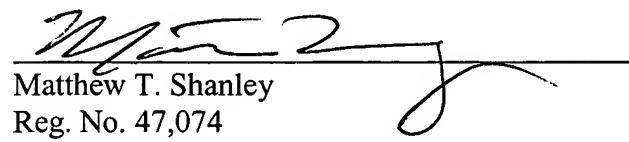
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Respectfully submitted,

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